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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,130	12/17/2001	Donna Stevens	2148US	3119
22881	7590	01/26/2005	EXAMINER	
Icoria, Inc. 108 T.W. ALEXANDER DRIVE P O BOX 14528 RTP, NC 27709-4528			NASHED, NASHAAT T	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/024,130

Applicant(s)

STEVENS ET AL.

Examiner

Nashaat T. Nashed, Ph. D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2, 3, 5-16, 20-29, and 31-39.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Nashaat T. Nashed, Ph. D.
Primary Examiner
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Claims 2, 3, 5-16, 20-29, and 31-39 are pending and under consideration.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-16, 20-29, and 31-39 are rejected under 35 U.S.C. 103 as being unpatentable over Robinson (U. S. P. 5,589,372) in view Wolf *et al.* (Analytical Biochemistry, Jan. 1991, 192 (1), 78-81), Nakashima *et al.* (Proc. Natl. Acad. Sci. U. S. A., March 1992, 92, 2328-2332), and the state of the art as exemplified by the cited references, and Ciosek *et al.* [J. Biol. Chem. November 1993, 268 (33), 24832-24837] for the reasons set forth in the prior Office actions mailed January 29, 2004, and October 20, 2004.

In response to the above rejection, applicants continue to argue that the examiner has not established *prima facie* case of obviousness because the prior art does not disclose that inhibitor of squalene synthase can be used as herbicides, and one of ordinary skill in the art.

Applicants arguments filed 12/20/05 have been fully considered, but they are found unpersuasive. It is true that the use of inhibitors of squalene synthase as herbicides is not disclosed in the cited prior art, but the use of inhibitor as herbicide is an intended use and carries no weight in patentability determination. Applicants should review the examiner argument addressing all their argument in the prior Office action mailed 10/20/04. As indicated previously, the prior art provides motivation to one of ordinary skill in the art to assay and develop inhibitors for plants squalene synthase as well as the teaching that the oxidation/reduction reaction of NAD(P)H/NAD(P) is accompanied by fluorescence change. Since said fluorescence change is independent of the substrate being reduced or oxidized and the enzyme being used including any squalene synthase, one of ordinary skill in the art would have had the expectation of success from the teaching of the prior art. Thus, the ordinary skilled in the art would have had the motivation, the teaching of the prior art, the skills to develop and use the method to obtain inhibitors for any plants squalene synthase, and therefore, the examiner has met his burden in establishing a *prima facie* case of obviousness. The claims remain rejected.

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1652